

Applicant : William Allen et al.  
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Attorney's Docket No.: 02103-581001 / AABOSW35

REMARKS

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The Description and Abstract have been amended to overcome minor informalities. Claims 1-20 have been amended to further patentably distinguish the invention from the prior art. Such amendments to claims are only for the purpose of expediting the prosecution of this application and are not to be construed as an abandonment of any of the novel concepts disclosed therein.

The office action states:

Claims 1-8, 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Ee et al. US Patent 6208341.

Regarding claims 1, 6, 13 Van Ee et al. teaches a method comprising providing, to a user of a control device, an indication of a value currently associated with a preset (time delay between macros as shown in figure 5), and simultaneously providing an indication of a possible new value of the preset by showing the sign to increment or decrement the delay time (col. 4 lines 8-18).

Regarding claims 2-3, Van Ee et al. teaches the preset is associated with works performed by a multi-media system (col. 4 lines 8-18).

Regarding claim 4, Van Ee et al. teaches the indications comprise graphical items on a display (col. 2 lines 15-19).

Regarding claim 5, Van Ee et al. teaches the display 202 is part of the control device (figure 2).

Regarding claims 7-8, Van Ee et al. teaches the control device communicates with a second device to effect the confirmed new preset value by transmitting the IR signal according to the preset delay value (col. 4 lines 8-18).

Regarding claim 12, Van Ee et al. teaches a method comprises a source of items to be performed (controlling the home theater), the source being configured to store the items for performance (control codes) in response to the preset (col. 3 lines 53-58).

Regarding claim 9, Van Ee et al. teaches enabling a user of a control device to indicate a possible new value of a preset (time delay between macros as shown in figure 5) (col. 4 lines 8-18) and to separately confirm the indication by selecting the delay using the arrow keys (col. 4 lines 15-25). Van Ee et al. further teaches using the new value to effect other device such as the TV, VCR and audio system (col. 4 lines 8-18).

Regarding claim 10, Van Ee et al. teaches the value comprises identifier of a station (TV-3) (col. 4 line 11).

Regarding claims 15-16, Van Ee et al. teaches a method comprising displaying values of possible selections at one level of a hierarchy of values, enabling a user to select one of the values at the one level of the hierarchy (col. 2

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Regarding claims 2-3, Van Ee et al. teaches the preset is associated with works performed by a multi-media system (col. 4 lines 8-18).

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Regarding claim 12, Van Ee et al. teaches a method comprises a source of items to be performed (controlling the home theater), the source being configured to store the items for performance (control codes) in response to the preset (col. 3 lines 53-58).

Regarding claim 9, Van Ee et al. teaches enabling a user of a control device to indicate a possible new value of a preset (time delay between macros as shown in figure 5) (col. 4 lines 8-18) and to separately confirm the indication by selecting the delay using the arrow keys (col. 4 lines 15-25). Van Ee et al. further teaches using the new value to effect other device such as the TV, VCR and audio system (col. 4 lines 8-18).

Regarding claim 10, Van Ee et al. teaches the value comprises identifier of a station (TV-3) (col. 4 line 11).

Regarding claims 15-16, Van Ee et al. teaches a method comprising displaying values of possible selections at one level of a hierarchy of values, enabling a user to select one of the values at the one level of the hierarchy (col. 2

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lines 5-6), and while at least a portion of the one level of the hierarchy is displayed, showing possible selections at a second, lower level of the hierarchy that correspond to the one of the values selected by the user, at least another portion of the one level being obscured (col. 2 lines 5-19). Pp. 2-4.

This ground of rejection is respectfully traversed.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. \*\*\* The

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Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. \*\*\* The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

While only claims 1-8 and 12-14 are said to be anticipated by this reference, it appears as if the Examiner intended to reject claims 9, 10, 15 and 16 as anticipated by this reference. These claims have been amended to positively recite that the values are representative of a sound signal source. Accordingly, withdrawal of the rejection of claims 1-10 and 12-15 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to at least the limitations as amended in the rejected claims.

The office action states:

Claims 17 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe US Patent Application Publication 20020031235.

Regarding claims 17 and 19-20, Abe teaches enabling a user at a control device to enter a command to cause muting of only a portion of a sound system, and enabling the user to enter a command to cause muting of at least another portion of the sound system (paragraph 006). P.4.

The reference only discloses muting a single signal on input terminal 1 from exiting on output terminal 2 whereas the claimed invention enables the user at a control device to enter a command to cause muting of only a subset of a zone of a multizone sound system and enabling the user to enter a command to cause muting of at least another subset of the multizone sound

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system. Accordingly, withdrawal of the rejection of claims 17 and 19-20 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to each limitation in claims 17, 19 and 20.

The office action states:

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Ee et al. US Patent 6208341 in view of Sass US Patent Application 20050065625.

Regarding claim 11, Van Ee et al. teaches controlling a home entertainment system including an audio device (col. 2 lines 55-60) but is not explicit in teaching a radio station and the media player comprises a radio receiver. Sass in an art related audio system invention teaches a media player having a radio receiver (paragraph 008) and one skilled in the art recognizes that an audio system is associated with a radio station in order to receive broadcast information.

It would have been obvious to one of ordinary skill in the art to have a radio station associated with the audio system and a media player comprising a radio receiver in Van Ee et al. as evidenced by Saas because Van Ee et al. suggests controlling a home entertainment system including an audio device and one skilled in the art recognizes that an audio system is associated with a radio station in order to receive broadcast information.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abe US Patent

Application Publication 20020031235 in view of Kamieniecki US Patent Application Publication 20030066080.

Regarding claim 18, Abe teaches entering command to control the device (paragraph 006) but is silent on teaching the command depends on duration of the entering of the command by the user. Kamieniecki in an art related remote control system teaches the command depends on duration of the entering of the command by the user by pressing a sequence of button in a predetermined time for entering the command (paragraph 003) in order to prevent activating a device just accidentally touch a button of the remote control.

It would have been obvious to one of ordinary skill in the art for the command depends on a duration of the entering of the command by the user in Abe as evidenced by Kamieniecki because Abe suggests entering command to control the device and Kamieniecki teaches the command depends on duration of the entering of the command by the user by pressing a sequence of button in a predetermined time for entering the command in order to prevent activating a device just accidentally touch a button of the remote control. Pp. 4-6.

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This ground of rejection is respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that

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reference. See *B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

Claim 11 is dependent upon and includes all the limitations of claims 9 and 10, and the reasoning advanced above in support of the patentability of claims 9 and 10 is submitted to support the patentability of claim 11.

Since claim 9 cannot be anticipated by the primary reference, it is impossible to combine the primary and secondary references to meet the limitations of claim 11.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981). That it is impossible to combine the references to meet the limitations of claim 11 is reason enough for withdrawing the rejection of it.

Similarly, claim 18 is dependent upon and includes all the limitations of claim 17 which is clear of the primary reference for reasons set forth above. Accordingly, it is also impossible to combine the references to meet the limitations of claim 18.

Accordingly, withdrawal of the rejection of claims 11 and 18 is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in each reference regarded as corresponding to each limitation in claims 11 and 18 and quote verbatim the language regarded as suggesting the desirability of combining what is there disclosed to meet the limitations of these claims.

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In view of the foregoing amendments, authorities, remarks and inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance and notice thereof is respectfully requested. Should the Examiner believe this application not be regarded as in a condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps the Examiner believes are necessary to place the application in a condition for allowance.

Please apply any other charges or credits to deposit account 06-1050, Order No. 02103-581001.

Respectfully submitted,  
FISH & RICHARDSON P.C.

Date: 30 December 2005

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